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20694	7590	01/14/2005	EXAMINER	
WOLFF & SAMSON, P.C. ONE BOLAND DRIVE WEST ORANGE, NJ 07052			ZHONG, CHAD	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,562

Applicant(s)

BAUER ET AL.

Examiner

Chad Zhong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-28, 34-44 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. The disclosure is objected to because of the following informalities:
pg 16, line 22, electronic communication service should be numbered 10 instead of 12.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

5. Claim 18-20, 22, 24-25, 1, 6-11, 13, 26-28, 34-35, 41-42, 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballard, US 6,182,050.

6. As per claim 18, Ballard teaches subscribing to the electronic communication service through a user interface using conventional name and conventional postal address information (Col. 6, lines 55-65);
obtaining an account (Col. 1, lines 67 – Col. 2, lines 5);
providing user preferences (Col. 2, lines 10-34); and

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receiving over the Internet direct mail advertising materials offered by businesses over the electronic communication service and matched to said user preferences based upon said conventional name and said conventional postal address information (see for example, Col. 1, lines 20-45; Col. 6, lines 55-65).

7. As per claim 19, Ballard teaches the method of claim 18 further comprising:
providing demographic information (Col. 2, lines 10-22); and
receiving targeted direct mail advertising materials from the businesses based upon said demographic information (Col. 2, lines 10-34).
8. As per claim 20, Ballard teaches the method of claim 18 further comprising receiving communications screened for undesired electronic mail and undesired offers (Col. 2, lines 10-33)
9. As per claim 22, Ballard teaches the method of claim 18 wherein said mailing information may be sorted according to categories (see for example, Col. 2, lines 10-33, wherein the desired targeted information registered by the clients categorize the types of advertisements to be sent out by the businesses).
10. As per claim 24, Ballard teaches the method of claim 18 further comprising receiving conventional postal mail when the user does not have an e-mail address or prefers to receive direct mail advertising materials by conventional postal mail (see for example, Col. 2, lines 10-35; Col. 1, lines 20-45; Col. 10, lines 55-65).
11. As per claim 25, Ballard teaches the method of claim 18 further comprising browsing offers matched and unmatched against said user preferences (Col. 2, lines 10-33).
12. As per claim 1, Ballard teaches wherein an electronic communication service method comprising:

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subscribing users to the electronic communication service using conventional name and conventional postal address information (Col. 1, lines 67 – Col. 2, lines 5);

subscribing businesses to the electronic communication service (Col. 2, lines 10-20, wherein businesses subscribe to 3rd party advertiser);

receiving direct mail advertising materials from the businesses; and

sending the direct mail advertising materials to the users over the Internet using the conventional name and conventional postal address information (see for example, Col. 1, lines 20-45; Col. 6, lines 55-65)

13. As per claims 6 and 7, claims 6 and 7 are rejected for the same reason as the rejection to claim 22 above.

14. As per claim 8, Ballard teaches obtaining demographic information from the users (Col. 2, lines 20-33);

15. As per claim 9, Ballard teaches the method of claim 1 further comprising allowing the users to specify types of the direct mail advertising materials which the users wish to receive (see for example, Col. 2, lines 10-35).

16. As per claim 10, Claim 10 is rejected for the same reason as the rejection to claim 25 above.

17. As per claim 11, Ballard teaches the method of claim 1 further comprising sending conventional postal mail when a user does not have an e-mail address or prefers to receive direct mail advertising materials by conventional postal mail (see for example, Col. 2, lines 10-35; Col. 1, lines 20-45, wherein the user has the option of receiving regular printed advertisements).

18. As per claim 13, Ballard teaches the method of claim 1 further comprising screening

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undesired electronic mail and undesired offers from users (Col. 2, lines 10-33).

19. As per claim 26, Ballard teaches an electronic communication service method for a business comprising:

subscribing to the electronic communication service (Col. 1, lines 67 – Col. 2, lines 5);

obtaining a business account (Col. 2, lines 10-20, wherein businesses subscribe to 3rd party advertiser);

providing conventional name and conventional postal address information from the business to the electronic communication service (Col. 3, lines 7-20; Col. 2, lines 10-33); and

allowing the service to send direct mail advertising materials to a plurality of users over the Internet using said conventional name and said conventional postal address information provided by the business.

providing direct mail advertising materials from the business to the electronic communication service; and allowing the service to send direct mail advertising materials to a plurality of users over the Internet (see for example, Col. 1, lines 20-50; Col. 2, lines 10-35; Col. 6, lines 55-65).

20. As per claim 27, Ballard teaches the method of claim 26 further comprising allowing the business to create target contact lists based upon a plurality of interested users (Col. 7, lines 1-15).

21. As per claim 28, Claim 28 is rejected for the same reason as the rejection to claim 19 above.

22. As per claim 34, Claim 34 is rejected for the same reasons as the rejection to claim 1 above.

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23. As per claim 35, Ballard teaches the method of the method of claim 34 wherein the step of subscribing businesses to the electronic communication service comprises subscribing the businesses at a remote location (Col. 3, lines 8-20; wherein the businesses can be incorporated as part of an end user).

24. As per claim 37, Claim 37 is rejected for the same reasons as rejection to claim 1 above.

25. As per claims 41, 42, 44, claims 41, 42, 44 are rejected for the same reasons as rejection to claims 7, 11, and 25 above respectively.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 21, 23, 24, 36, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,108,691, Ballard, US 6,182,050, in view of Lee et al. (hereinafter Lee).

28. As per claim 21, Ballard does not explicitly teach the method of claim 18 wherein correspondences sent and received without disclosing e-mail addresses.

29. Lee teaches the method of claim 18 wherein correspondences sent and received without disclosing e-mail addresses (Col. 6, lines 35-39; Col. 1, line 51, lines 63-65).

30. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Ballard and Lee because they both dealing with targeted advertising. Furthermore, the teaching of Lee to allow

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wherein correspondences sent and received without disclosing e-mail addresses would improve the security for Ballard's system by hiding user specific information such as email address from potential attackers.

31. As per claim 23, Ballard does not explicitly teach providing e-mail addresses and aliases; and consolidating electronic mail from said e-mail addresses and said aliases at a single location.

32. As per claim 23, Lee teaches the method of claim 18 further comprising: providing e-mail addresses and aliases (Col. 4, lines 27-34; Col. 6, lines 27-39); and consolidating electronic mail from said e-mail addresses and said aliases at a single location (Col. 2, lines 42-51; Col. 4, lines 48-49; Col. 6, lines 18-22).

33. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Ballard and Lee because they both dealing with targeted advertising. Furthermore, the teaching of Lee to allow providing e-mail addresses and aliases; and consolidating electronic mail from said e-mail addresses and said aliases at a single location. would improve the organization and security for Ballard's system by hiding user specific information such as email address from potential attackers and place them in a secure centralized location.

34. As per claim 2, Ballard does not explicitly teach the method of claim 1 wherein e-mail addresses of said users are maintained in confidence.

35. Lee teaches the method of claim 1 wherein e-mail addresses of said users are maintained in confidence (Col. 1, line 51; Col. 6, lines 35-39).

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36. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Ballard and Lee because they both dealing with targeted advertising. Furthermore, the teaching of Lee to allow wherein e-mail addresses of said users are maintained in confidence would improve the security for Ballard's system by hiding user specific information such as email address from potential attackers.

37. As per claim 3, Ballard does not explicitly teach the method of claim 2 wherein said e-mail addresses are maintained in confidence during and after any transactions between users and businesses.

38. Lee teaches the method of claim 2 wherein said e-mail addresses are maintained in confidence during and after any transactions between users and businesses (Col. 1, line 51; Col. 6, lines 35-39).

39. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Ballard and Lee because they both dealing with targeted advertising. Furthermore, the teaching of Lee to allow wherein said e-mail addresses are maintained in confidence during and after any transactions between users and businesses would improve the security for Ballard's system by hiding user specific information such as email address from potential attackers during the transaction.

40. As per claim 4, Claim 4 is rejected for the same reason as the rejection to claim 23 above.

41. As per claim 36, Ballard does not explicitly teach wherein the step of subscribing business to the electronic communication service comprises subscribing the businesses at a local

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location.

42. Lee teaches the method of claim 34 wherein the step of subscribing business to the electronic communication service comprises subscribing the businesses at a local location (Col. 4, lines 27-34; Col. 3, lines 17-42; Col. 8, lines 6-18, lines 30-33).

43. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Ballard and Lee because they both dealing with targeted advertising. Furthermore, the teaching of Lee to allow wherein the step of subscribing business to the electronic communication service comprises subscribing the businesses at a local location

would improve the Functionality for Ballard's system by allowing users to utilize said advertising service without the utilization of an internet.

44. As per claims 38-40, claims 38-40 are rejected for the same reasons as rejection to claim 2-4 above respectively.

45. Claims 12, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,108,691, Ballard, US 6,182,050, in view of Borgstrom et al. (hereinafter Borgstrom), US 6,738,053.

46. As per claim 12, Ballard does not explicitly teach the method of claim 1 wherein the conventional name and the conventional postal address information is converted to e-mail addresses through a mapping function.

47. Borgstrom teaches the method of claim 1 wherein the conventional name and the conventional postal address information is converted to e-mail addresses through a mapping

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function (Col. 7, line 57 – Col. 8, line 10).

48. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Ballard and Bogstrom because they both dealing with online advertisement. Furthermore, the teaching of Bogstrom to allow wherein the conventional name and the conventional postal address information is converted to e-mail addresses through a mapping function would improve the functionality for Ballard's system by shortening the data entry load of user for the data conversion aspect is realized through a predefined function.

49. As per claim 43, claim 43 is rejected for the same reasons as rejection to claim 12 above.

50. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard, US 6,182,050, in view of "UK CASE STUDY: THE POSTAL PREFERENCE SERVICE" Bryan, 1999.

51. As per claim 14, Ballard does not teach the method of claim 1 further comprising charging the businesses for sending the direct mail advertising materials.

52. Bryan teaches the method of claim 1 further comprising charging the businesses for sending the direct mail advertising materials (pg 4, "How much will this service cost me?", lines 1-4).

53. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Ballard and Bryan because they both deal with targeted advertising by the businesses. Furthermore, the teaching of Bryan to charge the businesses for sending the direct mail advertising materials would answer the question for funding and cost for Ballard's system by charging businesses for using the direct targeted advertisement service.

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Moreover, postal system isn't a free operating entity, it would have been obvious to charge the business for the postal service, in fact, Ballard suggests this charging of service see for example, Col. 2, lines 1-10.

54. As per claim 15 and 16, Claims 15 and 16 are rejected for the same reason as the rejection to claim 14 above.

55. Claims 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard, US 6,182,050, in view of "UK CASE STUDY: THE POSTAL PREFERENCE SERVICE" Bryan, 1999, in further view of 'Official Notice'.

56. As per claim 17, Ballard, and Bryan does not teach the method of claim 14 further comprising charging the businesses for converting said conventional postal address mailing lists to e-mail addresses. However, Official Notice is taken by the examiner that charging a fee for registered conversion services is notoriously well known for the advantage of keeping the service from going out of business.

57. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard, US 6,182,050, in view of 'Official Notice'.

58. Ballard teaches:

allowing users to selectively retrieve electronic communications (see for example, Col. 2, lines 10-33).

59. Ballard does not explicitly teach newsgroup server to post information, however, "Official Notice" is taken that the concept and advantages of providing for a newsgroup server is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to include a newsgroup server with Lee because it would provide easy of sharing of information

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as well as message postings in a client server environment.

Conclusion

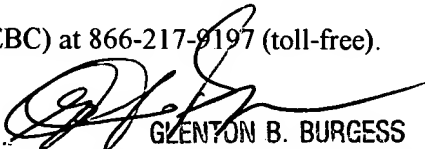
60. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Electronic Communication Service".

- i. "Direct MarketingOnline To Avoid Spam, Check source of email lists", Interactive PR & Marketing News, v5, n20, Oct 2, 1998.
- ii. "competition law – dominant market position – anti-competitive behaviour – Competition Act 1998", Collins, J Feb 11, 2000.
- iii. "UK CASE STUDY: The Postal Preference Service More of the mail you want, less of what you don't" 1999.
- iv. "How a Retailing Stalwart Plans To Apply Precision of Direct Marketing to the Web. (Company Business and Marketing)" Andrews, Whit. Internet World June 14, 1999.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BURGESS, GLENTON B can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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CZ

December 3, 2004